

ESTTA Tracking number: **ESTTA126135**

Filing date: **02/21/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Getty Petroleum Marketing Inc.
Granted to Date of previous extension	02/21/2007
Address	1500 Hempstead Turnpike East Meadow, NY 11554 UNITED STATES
Attorney information	David C. Lee Akin Gump Strauss Hauer & Feld LLP 1333 New Hampshire Ave., N.W. Washington, DC 20036 UNITED STATES dlee@akingump.com Phone:202.887.4000

### Applicant Information

Application No	78724366	Publication date	10/24/2006
Opposition Filing Date	02/21/2007	Opposition Period Ends	02/21/2007
Applicant	Lucas Oil Products Inc. 302 North Sheridan Street Corona, CA 928802067 UNITED STATES		

### Goods/Services Affected by Opposition

Class 004. First Use: 1989/07/31 First Use In Commerce: 1989/07/31

All goods and services in the class are opposed, namely: Non-chemical motor oil additive, non-chemical gasoline additive, non-chemical diesel fuel additive, non-chemical power steering fluid additive, non-chemical transmission fluid additive, industrial lubricating oil for gun barrels, lubricating oil for wheel hubs, lubricants for air powered tools, lubricants for fifth wheel trailer hitches, industrial lubricants and greases for gear chains

Attachments	LUCASOILPOSITION.pdf ( 5 pages )(233595 bytes )
Signature	/David C. Lee/
Name	David C. Lee
Date	02/21/2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GETTY PETROLEUM MARKETING INC.,

Opposer,

v.

LUCAS OIL PRODUCTS, INC.,

Applicant.

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

In the matter of Application Serial No. 78/724,366, in Class 4, for the mark LUCAS OIL, filed September 30, 2005, and published for opposition in the *Official Gazette* of October 24, 2006 (“Opposed Application”):

Opposer, Getty Petroleum Marketing Inc., a Maryland corporation, having an address at 1500 Hempstead Turnpike, East Meadow, New York 10036-6524 (“Opposer”), believes that it will be damaged if registration for the above mark is issued, and hereby opposes registration of said mark.

The grounds for the present opposition are as follows:

1. OAO Lukoil, a Russian Federation open joint stock company (Opposer’s affiliate and licensor), is one of the world’s leading integrated oil and gas producers and distributors. OAO Lukoil, through numerous subsidiaries, related companies, and/or affiliates including Opposer, produces, refines, and/or sells oil and oil products, and sells such products and operates gas stations under the LUKOIL mark and name around the world.
2. OAO Lukoil owns federal applications for LUKOIL and LUKOIL and Design marks in the United States for a wide range of automobile oil and fluids and services related

thereto, namely: LUKOIL, Application Serial No. 75/475,106 filed on April 27, 1998; LUKOIL and Design, Application Serial No. 75/475,100 filed on April 27, 1998; LUKOIL, Application Serial No. 76/388,904 filed on March 29, 2002; and LUKOIL and Design, Application Serial No. 76/388,903 filed on March 29, 2002.

3. Opposer is the exclusive licensee under the LUKOIL marks in the United States. Under the terms of its license agreement with OAO Lukoil, Opposer holds the exclusive right to use the LUKOIL and LUKOIL and Design marks in the United States in connection with, among other goods and services, gas stations, motor oils and additives.

4. Opposer directly or through its sublicensees, operates gas stations and provides related goods and services under the LUKOIL mark and name in the United States. There are currently approximately 500 LUKOIL branded gas stations in the Northeast region of the United States.

5. Opposer has promoted and continues to promote the LUKOIL marks and the goods and services provided thereunder in the United States through extensive advertising and other promotional efforts in connection with the LUKOIL gas stations and oil products. Opposer has spent over tens of millions of dollars in capital expenditures for the LUKOIL rebranding program, and additional tens of millions of dollars in supporting, promoting and advertising the LUKOIL motor fuel brand for sale to the motoring public at retail service stations in the United States.

6. As a result of the continuous and substantially exclusive and extensive use of the LUKOIL marks in United States commerce for gas station services and related consumer products/services sold through such gas stations, and the quality and success of the services and products provided thereunder, the LUKOIL marks have come to be well-known by the relevant

trade and public as an indicator of products and services originating with, sponsored by or otherwise associated with Opposer, exclusively.

7. Applicant, Lucas Oil Products Inc. (“Applicant”), seeks to register the mark LUCAS OIL for the following goods: “Non-chemical motor oil additive, non-chemical gasoline additive, non-chemical diesel fuel additive, non-chemical power steering fluid additive, non-chemical transmission fluid additive, industrial lubricating oil for gun barrels, lubricating oil for wheel hubs, lubricants for air powered tools, lubricants for fifth wheel trailer hitches, industrial lubricants and greases for gear chains” (collectively, “Applicant’s Goods”).

8. Applicant bases its application to register the LUCAS OIL marks (filed September 30, 2005) on an alleged use of the marks in commerce under Section 1(a) of the Trademark Act, claiming July 31, 1989 as the date of first use for Applicant’s Goods.

9. On June 16, 2006, Applicant filed a complaint (“Complaint”) in the United States District Court for the Southern District of New York against, *inter alia*, Opposer, alleging trademark infringement, unfair competition, and dilution under federal and state laws pertaining to the LUKOIL marks. In particular, Applicant has alleged that the marks LUKOIL and LUKOIL and Design, among others, are confusingly similar to LUCAS, LUCAS OIL, and HI-PERFORMANCE LUCAS OIL PRODUCTS INC. and Design.

10. Upon information and belief, Applicant has never used LUCAS OIL, the mark of the Opposed Application, for Applicant’s Goods in commerce. Accordingly, the Opposed Application should be refused.

11. Upon information and belief, Applicant has not used LUCAS OIL, the mark of the Opposed Application, as early as July 31, 1989, the earliest date of use of the mark claimed by Applicant in its Opposed Application, nor has Applicant used LUCAS OIL as of the filing

date of the Opposed Application. Accordingly, the Opposed Application should be refused.

12. Upon information and belief, Applicant knew, at the time of the filing of the Opposed Application and at the time Applicant submitted its substitute specimen, that the LUCAS OIL mark was not used in connection with any of Applicant's Goods. Despite this fact, Applicant knowingly made a material misrepresentation to the United States Patent and Trademark Office ("PTO") concerning use of the LUCAS OIL mark on a broad range of lubricants and additives for the purposes of securing a registration for the same. Such misrepresentation is material and a fraud upon the PTO. Accordingly, the Opposed Application should be refused.

13. In addition, LUCAS OIL is a primarily merely a surname mark, which is not inherently distinctive. According to the application information available through the on-line records of the United States Patent and Trademark Office, Applicant has not established secondary meaning in said marks in the Opposed Application. Accordingly, the surname mark opposed herein is not entitled to registration on the Principal Register, under Section 2(e)(4).

14. If Applicant were to be granted a registration for the LUCAS OIL mark, it would obtain thereby at least a *prima facie* exclusive, unrestricted right to use the mark for Applicant's Goods. Such registration would be a source of damage and injury to Opposer by providing Applicant with a basis to seek to (i) interfere with Opposer's sublicensees and claim superior rights over Opposer's use of the LUKOIL marks, (ii) prevent further rebranding under the LUKOIL mark, and (iii) restrict Opposer's rights under its trademark license in and to the LUKOIL marks.

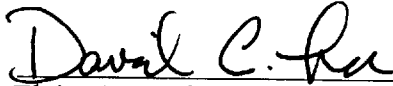
WHEREFORE, Opposer prays that this opposition be sustained and the registration of the mark of Application No. 78/724,366 be refused.

The Trademark Office is hereby authorized to charge the required fee in connection with this submission to Attorney Deposit Account No. 50-2310.

Respectfully submitted,

AKIN GUMP STRAUSS HAUER & FELD LLP

Date: February 21, 2007

By:   
Elaine M. Laflamme  
David C. Lee  
1333 New Hampshire Ave., N.W.  
Washington, DC 20036-1564  
Tel.: 202.887.4000  
Fax: 202.887.4282  
Email: [kkepchar@akingump.com](mailto:kkepchar@akingump.com)

***ATTORNEYS FOR OPPOSER***